

REMARKS

Summary of Office Action

Claims 1-6, 8, 10-33, 35, 37, 39-58, 60, 61, 63, and 65-68 are pending.

Claims 1-6, 8, 10-32, 35, 37, and 40-43 were rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-6, 8, 10-32, 35, 37, and 40-43 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 80, 81, 83-85, and 87-89 of copending Application No. 10/273,898.

Applicants' Reply to the Examiner's Rejections Under 35 U.S.C. § 112, second paragraph

Claims 1 and 44

The Examiner rejected claims 1 and 44 under 35 U.S.C. § 112, second paragraph.

Particularly, the Examiner stated "it is not understood how an image can be 'displayed in at least one or more of said one or more coin receivable apertures,' without the aperture being covered on one surface or side of the cover" (Office Action, page 3).

Of the numerous coin-receivable aperture structures that are covered by claims 1 and 44, at least one is provided in FIG. 2. as aperture 18. Thus, no further disclosure in the specification is needed as the Examiner has suggested in his statement that "applicant must further disclose what is supporting the 'image'" (Office Action, page 3).

The Examiner also stated that "if there is a 'support means' which holds the image in the aperture, then

the aperture is actually a 'recess' or 'pocket' not an 'aperture'" (Office Action, page 3).

It is well known that an applicant can be his own lexicographer. Furthermore, there are numerous structures that are coin-receivable aperture defined in the exterior of a book's cover that provide the ability to provide an image in the coin-receivable aperture (e.g., applicants' FIG. 2).

As the Appeal Board recognized on January 14, 2004 in its decision, there is a difference between an interior and exterior coin-receivable apertures and the difference is a novel one. None of the prior art, used either alone or in combination, including Plier et al. U.S. Patent No. 6,205,693 (hereinafter "Plier"), shows or suggests a coin-receivable aperture defined in the exterior of a book's cover (e.g., the exterior surface of Plier's cover is flat).

An exterior aperture for the purposes of claims 1 to 44 is not a hole accessible from both sides of the book's covers - but a hole, or opening, that is accessible from only the exterior of the book's covers. For at least the above reasons, applicants respectfully request that the Examiner's rejections under 35 U.S.C. § 112 be removed.

Claims 33 and 58

The Examiner rejected claims 33 and 58 Under 35 U.S.C. § 112, second paragraph.

Particularly, the Examiner stated that "it is not understood how 'one or more apertures' can be located on an 'interior' side of at least one of the book covers if the 'apertures' are located on 'the exterior' of the book covers as stated in Claim 1, lines 6 and 7" and "Claim 44, lines 6 and 7" (Office Action, page 3).

For at least the reasons discussed in connection with the Examiner's rejections of claims 1 and 44 under 35

U.S.C. § 112, applicants respectfully request that claims 33 and 58 are allowable. The apertures of FIG. 2, for example, may be placed on both the interiors and exteriors of a book's covers. Applicants respectfully submit that the rejection of claims 33 and 58 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Applicants' Reply to the Examiner's
provisional obviousness-type double patenting rejection

The Examiner provisionally rejected claims 1-6, 8, 10-33, 35, 37, 40-58, 60-63, and 65-68 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 80, 81, 83-85, and 87-89 of copending Application No. 10/273,898 (Attorney Docket No. HEH/002 CON). Application No. 10/273,898 is a continuation of the present application.

All of the claims of Application No. 10/273,898 currently stand rejected (as of the Office Action dated December 15, 2004).

Applicant would like to remind the Examiner that:

"if the 'provisional' double patenting rejection in one application is the only rejection remaining in that application, the Examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the 'provisional' double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent."

MPEP § 804.

As shown above, claims 1-6, 8, 10-33, 35, 37, 39-58, 60, 61, 63, and 65-68 are in condition for allowance. Accordingly, applicants respectfully requests that the provisional rejection of claims 1-6, 8, 10-33, 35, 37, 40-58, 60-63, and 65-68 be withdrawn.

Conclusion

Applicants have demonstrated the claimed subject matter, including claims 1-6, 8, 10-33, 35, 37, 39-58, 60, 61, 63, and 65-68, is in condition for allowance.

An early and favorable action is respectfully requested.

Respectfully submitted,



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